

In re application of MONBERG ET AL.
Serial No. 09/651,406

REMARKS

The Office action has rejected claims 1-14 and 20-23 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,930,474 to Dunworth et al ("Dunworth") in view of U.S. Publication No. 20020055878A1 to Burton et al ("Burton") and further in view of U.S. Patent 6,408,294 to Getchius et al ("Getchius"). The Office action has also rejected claims 15-19, 24-25 and 28-29 under 35 U.S.C. § 103(a) over Dunworth in view of Getchius. The Office action has also rejected claims 26-27 under 35 U.S.C. § 103(a) over Dunworth in view of Getchius and further in view of Burton. Applicants respectfully traverse these rejections. In the following, applicants provide an overview of their invention and then discuss the differences with the prior art of record.

Applicants' technique is generally directed towards maintaining information in the form of location bindings for a merchant that identify one or more regions serviced by the merchant, beyond only that region in which the merchant has a physical presence. For example, instead of maintaining a single ZIP code that corresponds to the merchant's address, a number of ZIP codes that the merchant services may also be maintained in association with the merchant, so that the merchant will be identified in response to a search request external to the merchant's ZIP code, but in a ZIP code serviced by the merchant as identified by the location bindings. Other aspects of the present invention are directed towards submitting a query for a merchant in a designated region, and

In re application of MONBERG ET AL.
Serial No. 09/651,406

receiving a business listing identifying a merchant that is not in the designated region, along with an explanation (such as text or glyph based) as to why that merchant was identified, e.g., the merchant services the region even though the merchant does not have a physical location in the region. Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

In contrast to the claims of the present invention, Dunworth teaches an on-line search of information based upon a geographic hierarchy. At specified levels of the geographic hierarchy, the user is presented with the option of accessing topically organized information from among several topic selections, wherein the topical information is customized for each geographic area to reflect topics indigenous to that area. For a selected topic within a geographical area, a local content database may be accessed to retrieve a URL for the topic and yellow pages may be accessed for retrieving a business location. The geographic areas can expand in a hierarchical manner, that is, an intermediate geographic area that includes a smaller geographic area can be searched, as can a larger geographic area that includes the intermediate geographic area (and thus the smaller geographic area). Dunworth, column 3, lines 46-54.

However, as acknowledged in the Office action, Dunworth fails to disclose the concept of maintaining location binding information that allows a business to be located when that business that does not have a physical location within a geographic area specified in a request. Instead, to locate such a business, Dunworth teaches that the database needs to search an expanded area by

In re application of MONBERG ET AL.
Serial No. 09/651,406

having the user manually ascend in the hierarchy (Dunworth, column 9, lines 1-4) until the geographic area specified in the request is enlarged sufficiently to include the location of the business. To this extent, Dunworth teaches away from the present invention, in which the location bindings automatically extend the search region, in effect, beyond that actually specified.

Notwithstanding the fact that (in contrast to the present invention) Dunworth teaches manually expanding and contracting the geographic search area, which requires significant user interaction, (as opposed to providing some teaching or suggestion as to how a business can be located in a search when it does not physically reside within a specified geographic area), the Office action contends that Burton, which teaches ordering supplies from a supplier using geographic information, can somehow be combined with Dunworth to reach the claims of the present invention. The Office action likewise contends that Getchius, which teaches a virtual business that need not have a particular physical location within a specified geographic area, can somehow be combined with Dunworth to reach the claims of the present invention. Applicants strongly disagree with these contentions. Specifically, Dunworth teaches away from such a combination by distinguishing his system from systems which have geographically differentiated listings for the same topic (such as job search databases which include information about jobs in different cities), since these listings are primarily related to the topic (e.g., jobs), not to the geographical area. (Column 5, lines 47-65).

In re application of MONBERG ET AL.
Serial No. 09/651,406

By law, in order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). As discussed in greater detail below, the claims of the present invention are thus clearly patentable over the teachings of the cited and applied references as a matter of law.

Turning first to independent claim 1, applicants recite the limitations of maintaining location binding information associating a merchant with a plurality of listed regions, including at least one listed region in which the merchant provides service and in which the merchant does not include a physical location, receiving a request directed to a particular region, and searching the location binding information associated with the merchant to determine if the particular region matches at least one of the listed regions, and if so, returning information regarding the merchant.

Applicants' technique thus may maintain information in the form of location bindings for a merchant that identify one or more regions serviced by the merchant, beyond only that region in which the merchant has a physical presence. Instead of maintaining a single location binding such as a merchant's address, a number of

In re application of MONBERG ET AL.
Serial No. 09/651,406

location bindings for separate regions where the merchant may provide services may also be maintained in association with the merchant, so that the merchant will be identified in response to a search request external to a specific region.

Dunworth does not teach or suggest the limitation of maintaining location binding information associating a merchant with a plurality of listed regions, including at least one listed region in which the merchant provides service and in which the merchant does not include a physical location. The Office action acknowledges that Dunworth does not teach maintaining location binding information associating a merchant with at least one listed region in which the merchant provides service and in which the merchant does not include a physical location. Office action page 8, line 13, and page 9, line 11. However, the Office action mistakenly contends that Dunworth may somehow be modified by combining Burton and Getchius for teaching the limitation of maintaining location binding information associating a merchant with a plurality of listed regions including at least one listed region in which the merchant provides service and in which the merchant does not include a physical location. Nowhere does Burton teach maintaining location binding information associating a merchant with a plurality of listed regions including at least one listed region in which the merchant provides service and in which the merchant does not include a physical location. Nor does the Office action contend that Burton teaches this limitation. Furthermore, Getchius does not teach maintaining location binding information associating a merchant with a plurality of listed regions including at least one listed region in which the merchant provides service and in which the merchant does not include a physical location. Nor does

In re application of MONBERG ET AL.
Serial No. 09/651,406

the Office action contend that Getchius teaches this limitation. Instead, the Office action surprisingly omits part of the claim language, namely "and in which the merchant does not include a physical location" and proceeds to contend that Burton teaches such a modified claim. However, this modified claim is not what applicants have recited. Applicants claim instead recites "including at least one listed region in which the merchant provides service *and in which the merchant does not include a physical location.*" By law, in order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). By improperly omitting claim language, the Office action has failed to consider all words in the claim in judging the patentability of that claim against the prior art.

Moreover, the Office action does not provide proper motivation for modifying Dunworth and/or combining the references. By law, in order to support a § 103(a) rejection, there must be some teaching, suggestion, or motivation other than applicants' teachings for modifying a cited reference or combining references to achieve the claimed invention. The Office action does not indicate any suggestion or motivation in the prior art of record, either explicit or otherwise, for modifying Dunworth or combining Dunworth with other references in a manner that would achieve the claimed invention. Instead the Office action concludes that "it would have been obvious to a person having ordinary skill in

In re application of MONBERG ET AL.
Serial No. 09/651,406

the art at the time the invention was made to have modified Dunworth et al by the teachings of Burton et al, because maintaining location binding information associating a merchant with a plurality of listed regions, including at least one listed region in which the merchant provides service, would enable the system to select prospective suppliers for a user in a given geographical location" and "it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al as modified to include the merchant that does not include a physical location." Office action, page 9, lines 5-10 and lines 18-20. Such broad, conclusory statements do not come close to adequately addressing the issue of motivation to modify or combine, are not evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The alleged motivation was clearly based on applicants' teachings, and not on anything found in the prior art or otherwise motivated. Such wholly speculative allegations cannot reasonably be used to support these claim rejections, and applicants respectfully request withdrawal of the §103(a) rejections of the claims for at least this additional reason.

Furthermore, Dunworth teaches away from geographically differentiated listings for the same business service. Dunworth distinguishes his system from systems which have geographically differentiated listings for the same topic (such as job search databases which include information about jobs in different cities), since these listings are primarily related to the topic (e.g., jobs), not to the geographical area. (Column 5, lines 47-65). Consequently, Dunworth teaches

In re application of MONBERG ET AL.
Serial No. 09/651,406

away from allowing a user to submit a query for a merchant in a designated region, and receiving a business listing identifying a merchant that is not in the designated region. Rather, to locate a business outside of the selected region, Dunworth teaches that the database needs to search an expanded area by having the user manually ascend in the hierarchy (Dunworth, column 9, lines 1-4) until the geographic area specified in the request is enlarged sufficiently to include the location of the business. Dunworth explicitly teaches away from the present invention, in which the location bindings automatically extend the search region, in effect, beyond that actually specified. If prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Thus, the claims of the present invention are clearly patentable over the teachings of the cited and applied references as a matter of law.

For at least these reasons, applicants submit that claim 1 is patentable over the prior art of record, whether considered alone or in any permissible combination.

Similarly, independent claims 8, 12, 15, 20, and 25 of the present invention recites the limitation of "location binding data representing a region in which the merchant provides service and in which the merchant does not include a physical location" or "the business listing being associated with a merchant that provides service to the region but does not have a physical location in the region" or "searching a database containing information associated with merchants

In re application of MONBERG ET AL.
Serial No. 09/651,406

located within the region and outside the region." Again, none of the prior art of record, including Dunworth, whether considered alone or in any permissible combination, disclose any such limitations. Nor could they, because Dunworth teaches away from geographically differentiated listings for the same business service. For at least these reasons, applicants submit that claims 8, 12, 15, 20 and 25 are allowable over the cited and applied references.

Regarding the dependent claims, applicants respectfully submit that dependent claims 2-7, 9-11, 13-14, 16-19, 21-24 and 26-29, by similar analysis, are not anticipated by Dunworth, Burton or Getchius, whether considered alone or in any permissible combination. Each of the dependent claims 2-7, 9-11, 13-14, 16-19, 21-24 and 26-29 includes the limitations of independent claims 1, 8, 12, 15, 20 and 25, respectively. As discussed above, none of the prior art of record, whether considered alone or in any permissible combination, disclose these limitations. In addition to the limitations noted above, each of these dependent claims includes additional patentable elements.

For at least these additional reasons, applicants submit that the claims are patentable over the prior art of record, whether considered alone or in any permissible combination. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested, and timely allowance of this application is earnestly solicited.

In re application of MONBERG ET AL.
Serial No. 09/651,406

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-29 of the present application are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



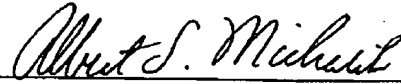
Albert S. Michalik, Reg. No. 37,395
Attorney for Applicants
Law Offices of Albert S. Michalik, PLLC
704 - 228th Avenue NE, Suite 193
Sammamish, WA 98074
(425) 836-3030
(425) 836-8957 (facsimile)

In re application of MONBERG ET AL.
Serial No. 09/651,406

CERTIFICATE OF TRANSMISSION

I hereby certify that this Amendment and Amendment Transmittal are being transmitted by facsimile to the United States Patent and Trademark Office in accordance with 37 C.F.R. 1.6(d) on the date shown below:

Date: August 17, 2004


Albert S. Michalik

2590 Second Response after RCE